



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/514,412	06/29/2005	Joerg Roth	DASI3001/FJD	4371

23364 7590 01/19/2007
BACON & THOMAS, PLLC
625 SLATERS LANE
FOURTH FLOOR
ALEXANDRIA, VA 22314

EXAMINER

SINGH, HIRDEPAL

ART UNIT	PAPER NUMBER
----------	--------------

2112

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/514,412

Applicant(s)

ROTH ET AL.

Examiner

Hirdepal Singh

Art Unit

2112

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/15/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This action is in response to the Preliminary amendment filed on November 15, 2004.

Claims 10-19 are pending and have been considered below.

Specification

1. If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 371, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the

Art Unit: 2112

prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference

Art Unit: 2112

in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

2. The disclosure is objected to because of the following informalities: the Examiner notes the use of acronyms (IC, and FF- module) on page 2 (lines 12, and 34) without including a description in plain text.

Appropriate correction is required.

3. The disclosure is objected to because of the following informalities: On page 8, line 18 it reads as "Especially is it possible_" seems like a typo error. The Examiner believes that it should be "Especially it is possible_" and will use this assumption in the office action below.

Appropriate correction is required.

Drawings

4. The drawings are objected to under 37 CFR 1.84(h)(5) because Figures 1-4 show(s) modified forms of construction in the same view. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

Art Unit: 2112

should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 10 recites the limitation "said communication module CU" in line 6.

However, the Applicant has described "a communication module CU" twice in lines 2, and 5. The Examiner believes that there should be only one "communication module CU" and will use this assumption in the office action below. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 2112

2. Claim 10 recites the limitation "said superordinated control" in line 7. However, claim 10 is the first independent claim and "superordinated control" is not described before. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 10-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Gillen (US 2003/0208290).

Claim 10: Gillen discloses a programmable field measuring instrument/device comprising;

- a. communication module for communication with control unit through data bus line (para 0027, lines 1-6);
- b. field measuring device has a sensor (module) which acquires the process data and ADC converts it to digital form (para0025, lines 1-4, fig 1);
- c. a control unit or processor for evaluating/processing the measured signal (para 0025, lines 4-8);

Art Unit: 2112

d. entire control takes place from a control (superordinated) center, signal transmits (communicates) via a digital databus (para 0003, lines 13-20);

e. a reprogrammable device/memory in field measuring device to install new control program (para 0008, lines 18-38), and the connector terminal serves as update interface to transfer new control programs (para 0031, lines 1-4).

Claim 11: Gillen discloses a programmable field measuring device as in claim 10 above, and further discloses that programmable field device 10 has communication module for communication between control unit and control (superordinated) center (fig 1, para 0027, lines 1-5).

Claim 12: Gillen discloses a programmable field measuring device as in claim 10 above, and further discloses that the field measuring device 10 has sensor module (fig 1, para 0025, lines 1-4).

Claim 13: Gillen discloses a programmable field measuring device as in claim 10 above, and further discloses that the field measuring device 10 has digital components of (sensor, ADC) sensor module (fig 1, para 0025, lines 3-8).

Claim 14: Gillen discloses a programmable field measuring device as in claim 10 above, and further discloses the field measuring device has control unit, processor, a memory with different control programs (para 0016, lines 1-4; and para 0025, line 6).

Claim 15: Gillen discloses a programmable field measuring device as in claim 10 above, and further discloses that the field measuring device's functionality can be changed by a control program which is called from the memory during the initialization/configuration of control unit (designated as SOPC) (para 28, lines 1-5).

Claim 16: Gillen discloses a programmable field measuring device as in claim 10 above, and further discloses a data interface 22 with databus line for communication according to Profibus PA standard, Foundation Fieldbus Controller, CAN Controller (para 0027, lines 8-14).

Claim 17: Gillen discloses a programmable field measuring device as in claim 10 above, and further discloses the input/output unit connected to the control unit for indicating outputting values, manual (analog) inputting values (fig 1, para 0027, lines 1-6).

Claim 18: Gillen discloses a programmable field measuring device as in claim 10 above, and further discloses that the field measuring device 10 has functionality (functional block) in form of (software) control program (fig 1, para 007, lines 1-5).

Claim 19: Gillen discloses a programmable field measuring device as in claim 18 above, and further discloses that the flexible (reprogrammable) functionality can be achieved by configuring the device by Foundation Fieldbus, Profibus (para 0027, lines 8-14).

Conclusion

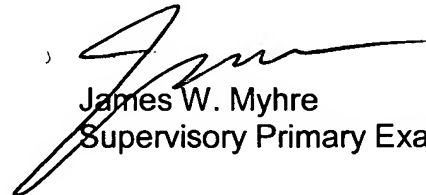
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- a. Eryurek et al. (US 6,859,755) discloses a field device for automatic process control.
 - b. Lynch (US 6,081,195) discloses a system with sensors having programmable logic circuit.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hirdepal Singh whose telephone number is 571-270-1688. The examiner can normally be reached on Mon-Fri (Alternate Friday Off) 8:00-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 703-308-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3800.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.S.
January 8, 2007
H.S.


James W. Myhre
Supervisory Primary Examiner